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Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors: MOSKOWITZ et al.	) Group Art Unit: 3621
	)
Application Serial No.: 09/542,367	) Examiner: Firmin Backer
	)
Filing Date: April 4, 2000	) **Appeal Brief Transmittal**
	)
For: SYSTEM AND METHOD FOR A FEE ADDRESS SYSTEM	) IBM Docket No. YOR9-2000-0171

Group Art Unit: 3621

Examiner: Firmin Backer

Appeal Brief Transmittal

IBM Docket No. YOR9-2000-0171
(Attorney Docket No.: I01.078)

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MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
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Sir:

Enclosed are:

1. ☑ **Appeal Brief**

2. ☑ Additional Enclosures: Acknowledgement Postcard

This is a petition for a two-month extension of time for response (from June 12, 2004 to August 12, 2004, based on the date of the Final Office Action).

The Commissioner is hereby authorized to charge and credit Deposit Account No. 50-0510 as described below. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,
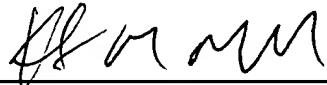
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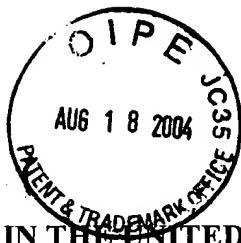
Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: MOSKOWITZ et al. Application Serial No.: 09/542,367 Filing Date: April 4, 2000 For: SYSTEM AND METHOD FOR A FEE ADDRESS SYSTEM	))))))))))))))))))))	Group Art Unit: 3621 Examiner: Firmin Backer **APPEAL BRIEF** IBM Docket No.: YOR9-2000-0171 Attorney Docket No.: I01.078 Buckley, Maschoff & Talwalkar LLC Five Elm Street New Canaan, CT 06840 (203) 972-0006

CERTIFICATE OF MAILING UNDER 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: MS Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date noted below:

Dated: 8/18/04   By: _Kurt M. Maschoff_
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MS Appeal Brief - Patents
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Sir:

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the decision of the Examiner in the Final Office Action mailed March 12, 2004 (the "Final Office Action"), rejecting claims 1, 2, 4-32 and 34-67.

REAL PARTY IN INTEREST

The present application is assigned to INTERNATIONAL BUSINESS MACHINES CORPORATION, North Castle Drive, Armonk NY 10504, U.S.A.

RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known to Appellants, Appellants' legal representative, or assignee, which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1, 2, 4-32, and 34-67 are pending in the application. All pending claims stand rejected under 35 U.S.C. §103(a) as being unpatentable over Council et al. (U.S. Patent Application Publication No. 2001/0023432) (hereinafter "Council"), in view of Knepper et al. (U.S. Patent Application Publication No. 2001/0042249 (hereinafter "Knepper").

STATUS OF AMENDMENTS

No amendments have been filed after the Final Office Action.

SUMMARY OF INVENTION

Appellants have developed systems and methods for discouraging senders from sending unwanted mail to recipients. Although techniques of some embodiments may be applied to other forms of communications, the present claims generally relate to systems that discourage senders from sending unwanted e-mail to recipients. That is, in some embodiments, Appellants have provided a system that discourages spam or other types of unwanted e-mail. (*See, e.g.*, the Specification as filed at page 2, lines 1-11).

Generally, embodiments of the present invention allow users (referred to as "recipients") to register with a central processing system to establish a "preferences record". (*Id.* at page 10, line 2 through page 11, line 5). Each recipient has both a public e-mail address and a private e-mail address. In general, a recipient only opens the e-mails received at his private e-mail address, and uses the public e-mail address as a forwarding address. The recipient provides third parties with his or her public e-mail address, and maintains the privacy of his or her private e-mail address. (*Id.* at page 5, lines 11-13).

Each recipient may establish preferences in his or her associated preferences record that specifies how messages received at the public (or "fee") e-mail address should be handled. (*Id.* at page 13, lines 10-21). Each preference record may define one or more "fee charging parameters" that specify whether certain types of e-mail received at the public e-mail address should be charged a fee for delivery to the recipient at the recipient's private e-mail address. (*Id.* at pages 8-11). For example, a preference record may specify that certain types of incoming e-mail should be assessed a flat fee for delivery to the recipient's private e-mail address. As another example, a preference record may specify that the fee will be larger for large messages, and smaller for small messages. The fee may also vary based on the priority of the message (*e.g.*, a message that is urgent, or must be opened the day received may be assessed a high fee, while a low priority message may be assessed a lower fee). (*Id.*)

The preferences record (or other account parameters) may also specify where the received fee is to be deposited or credited. For example, a recipient may provide information associated with his or her bank account and specify that any received fees be deposited in the bank account. In some embodiments, a sender is assessed a fee, which is deposited into an account associated with the system, and then the fee is credited to an account specified by the recipient. (*Id.* at page 20, line 11 through page 21, line 3). For example, the fee may be credited to the sender's bank account, or the fee may be donated to a charity or transferred to a third party. (*Id.* at page 11, lines 15-23).

A party that wishes to send an e-mail message to a recipient is only able to ensure the recipient receives (and, in some embodiments, opens) the e-mail message if the sender is willing to pay for the delivery. In this manner, embodiments "discourage the sender from bombarding recipients with excessive or very large pieces of mail." (*Id.* at page 2, lines 5-6).

ISSUES

Whether claims 1, 2, 4-32 and 34-67 are patentable under 35 USC §103 over Council et al (U.S. Patent Application Publication No. 2001/0023432, hereinafter "Council") in view of Knepper et al. (U.S. Patent Application Publication No. 2001/0042249, hereinafter "Knepper").

GROUPING OF CLAIMS

The group of claims 1, 2, 4-32, and 34-67, to which a single ground of rejection applies, do not stand or fall together as explained in the following section.

ARGUMENT

As will be explained, the rejections of each of the claims are improper because: (a) the cited combination fails to teach or suggest embodiments of the claimed invention, and/or (b) because the Examiner has improperly combined references (in particular, there is no adequate

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reasoning or support for making the proposed combinations). Therefore, Appellants respectfully request that the Examiner's rejections be reversed.

Claim 1 relates to an e-mail address system that includes means for monitoring information sent by a sender and asynchronously received at a public fee address associated with an e-mail recipient, wherein the information is unsolicited by the e-mail recipient. A fee is determined for the information, where the fee is based upon a preferences record defined by the e-mail recipient. The fee is collected from the sender into a first account, and the information is forwarded from the public fee address to a private e-mail address associated with the e-mail recipient. The collected fee is transferred to a second account. That is, two e-mail accounts are associated with the recipient, a public e-mail address and a private e-mail address. A received unsolicited e-mail is forwarded from the public e-mail address to the private e-mail address upon consultation with the recipient's preferences record and assessment of a fee if required by the preferences record.

The Council reference relates to an e-mail filtering system operated by an Internet Service Provider (ISP). When an email message is received by the ISP, the ISP compares the

> "source address with a list of source addresses associated with the destination address to determine whether the source address is an authorized source address. If so, the computer stores the message at the location in the ISP database corresponding to the mail box associated with the destination address, i.e., the intended recipient's mail box. If not, the computer sends an email message to the sending party in the form of an agreement or payment statement that provides the sending party with the option of paying a fee in return for the sending party's email communication to be ... [delivered to] the intended recipient." (Council at paragraph [0019]).

Put another way, Council describes an ISP system where the ISP computers can be configured to screen or filter all incoming messages and request payment for delivery of certain messages. Nothing in Council can be seen as teaching the use of both a public e-mail address and a private e-mail address, nor is there any teaching of a preferences record defined by the e-mail recipient that is used to determine a fee that is to be imposed to forward the message from the public e-mail address to the private e-mail address.

The Examiner asserts that Council teaches a system including means for monitoring information "received to a fee address associated with an email recipient"[1] and "means for forwarding the information from a public address to a private address" and refers to Council at paragraphs [0003]-[0005], [0011], [0019], [0023], [0024], [0030], and [0032]-[0033]. (Final Office Action at pages 2-3). These paragraphs of Council (and the other paragraphs of the publication) do not teach any private fee address. The address described in the Council reference is not a private address. A private address as described in the present application is an address not generally available to the public. In the Council patent, the sender has access to and addresses mail to one address: The public address of the recipient. The Council system captures the message, checks the sender's address to see if it is on an authorized list, and if it is, the message is allowed to pass to the addressed recipient's address. There is no forwarding from a public fee address to a private address because there is only a single address associated with the recipient. Contrary to the Examiner's assertion, the Council reference fails to teach or suggest the claimed use of both a public and a private e-mail address associated with a recipient. As such, the Council reference fails to teach or suggest embodiments of the present invention. As will be described further below, the Knepper reference fails to make up for this deficiency.

The Examiner agrees that the Council reference "fail[s] to teach an inventive concept with means for determining a fee for the information, wherein the fee is based upon a preference record defined by a mail recipient." (Final Office Action at page 2). Appellants agree that this feature is not seen in the Council reference. Instead, the Council reference describes that any fees assessed are determined by the ISP, not by a preferences record defined by the e-mail recipient. As such, Council fails to teach or suggest a system having (1) both a public and a private fee address associated with a recipient, and (2) a preferences record defined by the mail recipient which determines a fee for information.

The Examiner cites the Knepper reference as "teaching an inventive concept with means for determining a fee for the information, wherein the fee is based upon a preferences record defined by a mail recipient." (Final Office Action at page 2). The Examiner refers to Knepper at

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[1] The Examiner, apparently, ignores the recitation that the fee address of claim 1 is a "public fee address associated with an e-mail recipient".

paragraph [0041]. The Knepper reference is seen as describing a system for joining encoded video streams for continuous play, and is not seen as describing (or even relevant to) a system for forwarding emails and assessing fees. A review of the Knepper reference and the portion cited by the Examiner reveals no description of any preferences record as recited in claim 1 (e.g., where the preferences record is set up by a mail recipient to determine fees to be assessed to incoming messages).

Appellants respectfully assert that neither Council nor Knepper, alone or in any combination, teach or suggest a system having (1) both a public and a private fee address associated with a recipient, and (2) a preferences record defined by the mail recipient which determines a fee for information.

Further, even if Knepper did teach the use of such a preferences record (which Appellants assert it does not), it would not have been obvious to modify the Council reference to incorporate the record of Knepper.

To properly establish a case of obviousness over a combination of references, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

The Examiner has not provided a proper motivation to modify or combine the references, nor is one available (and certainly, there is no indication of a "reasonable expectation of success" that has been provided).

Nowhere in the Council or Knepper references is any suggestion or motivation to make the combination suggested by the Examiner. As asserted by the Examiner,

> it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the inventive concept of Council et al to include Knepper's an [sic] inventive concept with means for determining a fee for the information, wherein the fee is based upon a preferences record defined by a mail recipient because this would have ensure the proper amount be charge and paid for the email received by the intended recipient thereby enhance the efficiency of the system. (Final Office Action at page 2).

Appellants respectfully do not understand this reasoning. It appears that the Examiner believes that the combination is proper simply because the Examiner feels the "efficiency" would somehow be enhanced. How would a skilled person have concluded that the combination of a video streaming system with an email filtering system would result in a system with increased efficiency? Why would a skilled person have believed that a user-defined record is more efficient than a system defined fee record? Appellants respectfully assert that the Examiner's reasoning is flawed and that the motivation to combine is improper.

Such general statements about the broad field of the invention fall far short of a motivation to combine these particular references in a way that would make the <u>particular invention recited in claim 1</u> obvious. Similarly, the statement that "efficiency" could be "enhanced" is not "a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references" as required for a *prima facie* case of obviousness. *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

Further, even if the two references could potentially be combined, the resulting system would still lack elements of the claimed invention. For example, as discussed above, neither

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Council nor Knepper teach or suggest the use of both a private and a public fee address associated with an email recipient. The asserted combination fails to describe a system having any or all of these features, and the Examiner has not provided any motivation to modify either of the references to provide them.

In view of the above, claim 1 is patentable under 35 U.S.C. § 103 over Council and Knepper, and Appellants respectfully request that the Examiner's rejection be reversed and/or the claims allowed. Each of the other pending claims contain limitations similar to those described above with respect to claim 1 and are patentable at least for the reasons described above. Each of the pending claims are believed patentable over the cited references, alone or in any combination.

Other claims recite additional features not taught or suggested by the cited references. For example, claims 5, 19-21, 35, and 54 recite that the fees are conditional (e.g., the user may define conditions in the preferences record that trigger different payment requirements). Claims 10, 16-17, 22-30, 40, 46-47, 59, 65-66 recite that fees are based on a size of the received email (e.g., based on the number of bits or based on a word count). Claims 8, 38, and 57 recite that the fee is based on an urgency of the message (e.g., a message having a higher urgency may be assessed a higher fee). None of these features are taught or suggested by the cited references, and the claims are patentable for at least this additional reason.

CONCLUSION

The rejections of claims 1, 2, 4-32 and 34-67 are improper at least because the Examiner has failed to cite references which teach or suggest each of the elements of the claims and further because the Examiner has improperly combined references (*i.e.*, there is no adequate reasoning or support for making the proposed combinations). Therefore, Appellants respectfully request that the Examiner's rejections be reversed and that all claims be allowed. The Final Office Action presents a number of characterizations regarding each of the applied references, some of which are not directly addressed herein because they are not related to the rejections of the

independent claims. Appellants do not necessarily agree with the characterizations and reserves the right to further discuss those characterizations.

A petition for an extension of time to respond is submitted herewith (from June 12, 2004 to August 12, 2004, as measured from the date of mailing of the Final Office Action). If any additional fees are due in conjunction with this matter, the Commissioner is hereby authorized to charge them to Deposit Account 50-0510. An Appendix of claims involved in this appeal is attached hereto.

If any issues remain, or if the Examiner or the Board has any further suggestions for expediting allowance of the present application, kindly contact the undersigned using the information provided below.

Respectfully submitted,

August 12, 2004
Date

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Attachment: Appendix of claims

APPENDIX

1.   An e-mail address system, comprising:

means for monitoring information sent by a sender and asynchronously received at a public fee address associated with an e-mail recipient, wherein the information is unsolicited by the e-mail recipient;

means for determining a fee for the information, wherein the fee is based upon a preferences record defined by the e-mail recipient;

means for collecting the fee from the sender into a first account;

means for forwarding the information received at the public fee address to a private e-mail address associated with the e-mail recipient; and

means for transferring the collected fee to a second account.

2.   The address system of claim 1, wherein the second account belongs to a third party.

4.   The address system of claim 1, wherein the fees are escalating based upon number of usages.

5.   The address system of claim 1, wherein the fees are conditional.

6.   The address system of claim 1, wherein the fees are a combination of fixed, variable and conditional for different senders.

7.   The address system of claim 1 wherein the fee is waived for a sender.

8.   The address system of claim 1 wherein the fee is based upon the urgency of the information.

9.   The address system of claim 1 wherein the fees are selected from the group consisting of fixed, variable or conditional.

10. The address system of claim 1 wherein the fee is based on the size of the information.

11. The address system of claim 2 wherein the third party is a charity organization.

12. The address system of claim 2 wherein the third party is a company.

13. The address system of claim 2 wherein the third party is an individual.

14. The address system of claim 2 wherein the third party is a firm.

15. The address system of claim 1 wherein the fee varies for different senders.

16. The address system of claim 10 wherein the size of the information is based on word count.

17. The address system of claim 10 wherein the size of the information is based on number of bits.

18. The address system of claim 5, wherein the e-mail recipient elects to impose a fee.

19. An e-mail address system, comprising:

means for monitoring information sent by a sender and asynchronously received at a public fee address associated with an e-mail recipient, wherein the information is unsolicited by the e-mail recipient;

means for determining a fee for the information, wherein the fee is based upon a preferences record defined by the e-mail recipient and the fee is conditional;

means for collecting the fee from the sender; and

means for forwarding the information received at the public fee address to a private e-mail address associated with the e-mail recipient.

20.   The address system of claim 19, wherein the e-mail recipient elects to impose a charge.

21.   The address system of claim 19, wherein the e-mail recipient receives a portion of the collected fees.

22.   A method of providing an e-mail fee address system, comprising:

receiving information sent by a sender at a public fee address in a computer, wherein the public fee address is associated with an e-mail recipient, and wherein the information is unsolicited by the e-mail recipient;

determining a fee for the information, wherein the fee is based upon a preferences record defined by the e-mail recipient and the fee increases as information size increases;

collecting the fee from the sender; and

forwarding the information from the public fee address to a private e-mail address associated with the e-mail recipient.

23.   The method of claim 22, wherein the information size is measured by word count.

24.   The method of claim 22, wherein the information size is measured in bits.

25.   The method of claim 22 further comprising transferring the collected fees to a third party.

26.   The method of claim 25 wherein the third party is a charity.

27.   The method of claim 25 wherein the third party is a firm.

28.   The method of claim 25 wherein the third party is an individual.

29.   The method of claim 25 wherein the third party is a company.

30.   The method of claim 22 wherein the information is electronic mail.

31.   A programmed computer for providing an e-mail fee address system, comprising:

a memory having at least one region for storing computer executable program code; and

a processor for executing the program code stored in memory, wherein the program code includes:

code to receive an e-mail sent by a sender to a public fee address associated with an e-mail recipient, wherein the e-mail is unsolicited by the e-mail recipient;

code to determine a fee for the e-mail, wherein the fee is based upon a preferences record defined by the e-mail recipient;

code to collect the fee from the sender into a first account;

code to forward the e-mail from the public fee address to a private e-mail address associated with the e-mail recipient; and

code to transfer the collected fee to a second account.

32.   The programmed computer of claim 31 wherein the second account belongs to a third party.

34.   The programmed computer of claim 31, wherein the fees are escalating based upon number of usages.

35.   The programmed computer of claim 31, wherein the fees are conditional.

36.   The programmed computer of claim 31, wherein the fees are a combination of fixed, variable and conditional for different senders.

37.   The programmed computer of claim 31 wherein the fee is waived for a sender.

38.   The programmed computer of claim 31, wherein the fee is based upon the urgency of the e-mail.

39.   The programmed computer of claim 31 wherein the fees are selected from the group consisting of fixed, variable or conditional.

40. The programmed computer of claim 31, wherein the fee is based on the size of the e-mail.

41. The programmed computer of claim 32 wherein the third party is a charity organization.

42. The programmed computer of claim 32 wherein the third party is a company.

43. The programmed computer of claim 32 wherein the third party is an individual.

44. The programmed computer of claim 32 wherein the third party is a firm.

45. The programmed computer of claim 31 wherein the fee varies for different senders.

46. The programmed computer of claim 40, wherein the size of the e-mail is based on word count.

47. The programmed computer of claim 40, wherein the size of the e-mail is based on number of bits.

48. The programmed computer of claim 35, wherein the e-mail recipient elects to impose a fee.

49. Computer executable software code stored on a computer readable medium, the code for providing an e-mail fee address system, comprising:

code to receive a communication sent by a sender to a public fee address associated with an e-mail recipient, wherein the communication is unsolicited by the e-mail recipient;

code to determine a fee for the communication, wherein the fee is based upon a preferences record defined by the e-mail recipient;

code to collect the fee; and

code to forward the communication from the public fee address to a private e-mail address associated with the e-mail recipient.

50.   A method of providing an e-mail fee address system, comprising:

receiving an e-mail sent by a sender to a public fee address in a computer wherein the public fee address is associated with an e-mail recipient, and wherein the e-mail is unsolicited by the e-mail recipient;

determining a fee for the e-mail, wherein the fee is based upon a preferences record defined by the e-mail recipient;

collecting the fee from the sender into a first account;

forwarding the e-mail from the public fee address to a private e-mail address associated with the e-mail recipient; and

transferring the collected fee to a second account.

51.   The method of claim 50, wherein the second account belongs to a third party.

53.   The method of claim 50, wherein the fees are escalating based upon number of usages.

54.   The method of claim 50, wherein the fees are conditional.

55.   The method of claim 50, wherein the fees are a combination of fixed, variable and conditional for different senders.

56.   The method of claim 50 wherein the fee is waived for a sender.

57.   The method of claim 50, wherein the fee is based upon the urgency of the e-mail.

58.   The method of claim 50 wherein the fees are selected from the group consisting of fixed, variable or conditional.

59.   The method of claim 50, wherein the fee is based on the size of the e-mail.

60.   The method of claim 51 wherein the third party is a charity organization.

61. The method of claim 51 wherein the third party is a company.

62. The method of claim 51 wherein the third party is an individual.

63. The method of claim 51 wherein the third party is a firm.

64. The method of claim 50 wherein the fee varies for different senders.

65. The method of claim 59, wherein the size of the e-mail is based on word count.

66. The method of claim 59, wherein the size of the e-mail is based on number of bits.

67. The method of claim 54, wherein the e-mail recipient elects to impose a fee.